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Supreme Court of the United States

OCTOBER TERM, 1942.

No. 1100 108

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

vs.

F. W. WOOLWORTH COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

W. B. MORTON,
H. STANLEY MANSFIELD,
Counsel for Petitioner.

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STATUTE CITED

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28 U. S. Code, Sec. 347 6

TEXT BOOKS CITED

Robinson on Patents, Vol. 1, Sec. 83 9

Patentability of Inventions and the Interpretation of Patents, by Roberts, Vol. 1, Chap. III, pages 185, 245 10

IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

JOHN H. WALLACE, JR., doing business as WALLACE LABORATORIES,

Petitioner,

vs.

F. W. WOOLWORTH COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, John H. Wallace, Jr., doing business as Wallace Laboratories, prays that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit, entered herein on the 3rd day of March, 1943 (R. 378).

A petition for rehearing by that court was duly presented and was denied on the 19th day of March, 1943 (R. 393).

A certified transcript of the record of the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement Of The Matter Involved.

This is an action brought against the respondent in the United States District Court for the Eastern District of New York for infringement of United States Patent No. 2,236,387 by the petitioner Wallace, a joint patentee and the sole owner of the patent.

The District Court held the patent infringed (R. 370, finding 7) but invalid for lack of patentable invention (R. 369) and entered the usual judgment dismissing the complaint (R. 372). On appeal, the Court of Appeals for the Second Circuit affirmed that judgment (R. 394).

The patent in suit covers a composition for checking the flow of perspiration. Preparations for this purpose consisting of solutions of aluminum chloride or aluminum sulphate had been on the market for many years (R. 15, 105). These chemicals are mildly acid. Their acid character is "essential in bringing about the anti-perspirant effect" (R. 72). When heated to temperatures such as occasioned by the ironing of clothing they break down into strong, corrosive mineral acids. They "were unsatisfactory because they frequently produced skin irritations and rotted clothing fabrics in contact with the treated areas" (Opinion of Circuit Court of Appeals, R. 379).

The patentees initiated a program of chemical research to find an innocuous substance which could be added to the old preparations and would be inert with respect to the mildly acid aluminum sulfate or aluminum chloride constituting the anti-perspirant agent, but would react with and render harmless the strong sulfuric or hydrochloric acid which might be produced. After a series of cut and try experiments in which they "tried 'a complete range of alkalies' to neutralize the acid", they finally tried "urea and related compounds. The urea seemed to do the trick" and the result was a harmless and effective anti-perspirant, "a commercially satisfactory article that met with wide success" (Opinion of Circuit Court of Appeals, R. 381).

Urea is a known organic chemical substance. Chemists generally knew that urea would combine with strong mineral acids (Shipp patent, R. 177), and it had been proposed that urea be used to stabilize salts such as aluminum acetate and aluminum formate which normally decompose and produce insoluble compounds upon standing (Koch patent, R. 215).

The Circuit Court of Appeals was confused as to the facts in including Killian with Montenier in its statement that:

> "urea was the neutral protective ingredient that about the same time occurred to Wallace, Hand, Killian and Montenier."

The application for the patent in suit was in interference in the Patent Office with the application of one Montenier. Priority was awarded the joint patentees Wallace and Hand (R. 317). Killian, on behalf of petitioner, when petitioner's product was first marketed, conducted a series of tests to establish the efficacy of the protective agent in checking the corrosive action of the strong acids on fabrics (R. 12, 13).

The Court's ruling is in effect a holding that the validity of a patent is impaired by an interference in the Patent Office, even though the patentee receive the award of priority.

The Circuit Court of Appeals for the Second Circuit held that what the patentees did was the result of skillful experimentation where the principles of investigation were well known, and that this required "mere routine work rather than imagination" and did not involve invention (Opinion, R. 381). While conceding that "such steps might perhaps . . . lead to invention if the result was sufficiently unexpectable", that Court found that "No particular talent was involved in developing the plaintiff's product but only a process of routine experimentation by industrious chemists" (Opinion, R. 381).

The Question Presented.

Does the patentability of a new combination, derived by experimentation and productive of a new and desirable result, depend at all upon the mental process by which it was discovered?

The Reason For Granting The Writ.

Determination of the question of invention herein by the Circuit Court of Appeals for the Second Circuit by consideration of the mental process by which the thing patented was discovered is in direct conflict, on a point of law, with the doctrine that it is the fact of accomplishment rather than the method of accomplishment with which judicial inquiry is concerned, which doctrine has been announced by the Circuit Court of Appeals for the Seventh Circuit in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. (2d) 812, and has been applied by this Honorable Court in a long line of decisions. The petition for the writ should be granted "because of the importance of the problem and to the public" and because of "the contrarity of views" which have developed concerning it (*Freeman* v. *Bee Machine Co., Inc.*, —— U. S. ——; 57 USPQ 349, 351, decided June 1, 1943).

WHEREFORE, your petitioner prays that a writ of certiorari issue out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Second Circuit, commanding said court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of said Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court and that the judgment of the Circuit Court of Appeals be

reversed, and that petitioner may be granted such other and further relief in the premises as to this Court may seem just and proper.

JOHN H. WALLACE, JR., doing business
as WALLACE LABORATORIES,

By W. B. MORTON,
Counsel for Petitioner.

Dated: New York, N. Y.,
June 16, 1943.